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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,774	02/12/2004	Philip Ted Kortum	1030-LB1039	2947
66/533	7/5/0	08/04/2008		
TOLER LAW GROUP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759			EXAMINER AJIBADE AKONAI OLUMIDE	
			ART UNIT	PAPER NUMBER
			2617	
			MAIL DATE	DELIVERY MODE
			08/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,774

Applicant(s)

KORTUM ET AL.

Examiner

OLUMIDE T. AJIBADE AKONAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-12, 14 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-12, 14 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 May 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-7, 9-12, 14 and 23-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 31 objected to because of the following informalities: Claim 6 depends on claim, but there is no claim 38 in the current application. For the purpose of the current action, the examiner will assume that claim 31 depends on claim 28. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-7, 9-12, 14, 23-26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Granberg 6,195,543** in view of **Benco et al 7,068,997** (hereinafter **Benco**).

Regarding **claim 1**, Granberg discloses a method comprising determining a first real-time, cost-per-unit-time billing rate for an in-progress telephone call of a wireless telephone (calculating call charges, see abstract, figs. 1 and 3, col. 5, lines 56-67, col. 6, lines 1-13); and transmitting the first real-time, cost-per-unit-time billing rate to the wireless telephone (see col. 5, lines 56-67, col. 6, lines 1-12) for display of the first real-

time, cost-per-unit-time billing rate (see col. 5, lines 56-67, col. 6, lines 1-12) on a display of the wireless telephone during the in-progress telephone call (displaying call charges during the call, see abstract, col. 6, lines 1-13).

Granberg does not specifically disclose determining a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call of a wireless telephone; transmitting the determined first real-time, cost-per-unit-time billing rate and the first billing rate description to the wireless telephone for display of the first real-time, cost-per-unit-time billing rate and the first billing rate description on a display of the wireless phone during the in-progress call.

In the same field of endeavor, Benco discloses determining a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call of a wireless telephone (determining the per-minute rate of the MS, as the MS roams to an area outside of its service plan, see fig. 2, col. 3, lines 34-57); and transmitting the determined first real-time, cost-per-unit-time billing rate and the first billing rate description to the wireless telephone for display of the first real-time, cost-per-unit-time billing rate and the first billing rate description on a display of the wireless phone during the in-progress call (transmitting the per-unit roaming charge to the user as the user travels out of a service area and displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco, by displaying

roaming charges on a mobile phone, into the system of Granberg for the benefit of informing a mobile subscriber of the current charges to his current mobile communication session.

Regarding **claim 9**, Granberg discloses a wireless telephone (mobile station 13, see fig. 2, col. 5, lines 27-28) comprising: a receiver to receive a first real-time, cost-per-unit-time billing rate for an in-progress call (see col. 5, lines 56-67, col. 6, lines 1-12) and a display to display the first real-time, cost-per-unit-time billing rate during the in-progress call (displaying call charges during the call, see abstract, col. 6, lines 1-13).

Granberg does not specifically disclose a wireless telephone comprising: a receiver to receive a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call; and a display to display the billing rate description during the in-progress telephone call.

In the same field of endeavor, Benco discloses a wireless telephone (MS 24, 30, see fig. 1, col. 3, line 6) comprising: a receiver to receive a first real-time, cost-per-unit-time billing rate and a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call (transmitting the per-unit roaming charge to the user as the user travels out of a service area to the user, see col. 4, lines 17-40); a display to display the first real-time, cost-per-unit-time billing rate and the billing rate description during the in-progress telephone call (transmitting the per-unit roaming charge to the user as the user travels out of a service area and displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco, by displaying roaming charges on a mobile phone, into the system of Granberg for the benefit of informing a mobile subscriber of the current charges to his current mobile communication session.

Regarding **claim 23**, Granberg discloses a system comprising: a message generator (control point 11, see fig. 1, col. 5, line 56) to determine a first real-time, cost-per-unit-time billing rate and a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call of a wireless telephone (determining advice of charge parameters for a call, see abstract, figs. 1 and 3, col. 5, lines 56-67, col. 5, lines 54-67, col. 6, lines 1-13), and to generate a first message having data that indicates the first real-time, cost-per-unit-time billing rate (see figs. 1 and 3, col. 5, lines 56-67, col. 5, lines 54-67, col. 6, lines 1-13).

Granberg does not specifically disclose generating a first message having data that indicates the first real-time, cost-per-unit-time billing rate and the first billing rate description to the wireless telephone during the in-progress telephone call; and a wireless service provider to transmit the first message to the wireless telephone for display of the first real-time, cost-per-unit-time billing rate and the first billing rate description during the in-progress telephone call.

In the same field of endeavor, Benco discloses generating a first message having data that indicates the first real-time, cost-per-unit-time billing rate and the first billing rate description to the wireless telephone during the in-progress telephone call

(determining the per-minute rate of the MS, as the MS roams to an area outside of its service plan, see fig. 2, col. 3, lines 34-57); and a wireless service provider (wireless network, see col. 4, line 28) to transmit the first message to the wireless telephone for display of the first real-time, cost-per-unit-time billing rate and the first billing rate description during the in-progress telephone call (transmitting the per-unit roaming charge to the user as the user travels out of a service area and displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco, by displaying roaming charges on a mobile phone, into the system of Granberg for the benefit of informing a mobile subscriber of the current charges to his current mobile communication session.

Regarding **claim 28**, Granberg discloses a method comprising receiving at a wireless telephone (mobile station 13, see fig. 2, col. 5, lines 27-28) a first real-time, cost-per-unit-time billing rate for an in-progress call (see col. 5, lines 56-67, col. 6, lines 1-12) and displaying the first real-time, cost-per-unit-time billing rate on a display of the wireless telephone during the in-progress telephone call (displaying call charges during the call, see abstract, col. 6, lines 1-13).

Granberg does not specifically disclose receiving at a wireless telephone a first billing rate description associated with the first real-time, cost-per-unit-time billing

rate for an in-progress telephone call; and displaying the billing rate description on a display of the telephone during the in-progress telephone call.

In the same field of endeavor, Benco discloses receiving at a wireless telephone (MS 24, 30, see fig. 1, col. 3, line 6) a first real-time, cost-per-unit-time billing rate and a first billing rate description associated with the first real-time, cost-per-unit-time billing rate for an in-progress telephone call (transmitting the per-unit roaming charge to the user as the user travels out of a service area to the user, see col. 4, lines 17-40); and displaying the first real-time, cost-per-unit-time billing rate and the billing rate description on a display of the wireless telephone during the in-progress telephone call (transmitting the per-unit roaming charge to the user as the user travels out of a service area and displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco, by displaying roaming charges on a mobile phone, into the system of Granberg for the benefit of informing a mobile subscriber of the current charges to his current mobile communication session.

Regarding **claim 2**, as applied to claim 1, Granberg further discloses determining a second real-time, cost-per-unit-time billing rate for the in-progress telephone call of the wireless telephone (calculating a charge for a call due to changing conditions, see col. 6, lines 3-10); and transmitting the second real-time, cost-per-unit-time billing rate for display of the wireless telephone during the in-progress telephone

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call (displaying call charges during the call, see abstract, col. 6, lines 1-13). Benco further discloses determining a second billing rate description associated with the second real-time, cost-per-unit-time billing rate (see col. 4, lines 17-40) and transmitting the determined second real-time, cost-per-unit-time billing rate and the second billing rate description for display of the second real-time, cost-per-unit-time billing rate and the second billing rate description on the display of the wireless telephone (see col. 4, lines 17-40).

Regarding **claims 3, 11, 25, and 31**, as applied to claims 2, 10, 24, and 28, Granberg further discloses wherein the second real-time, cost-per-unit-time billing rate differs from the first, cost-per-unit-time billing rate (see col. 6, lines 3-7). Benco discloses wherein the second billing rate description differs from the first billing rate description (see col. 4, lines 17-40).

Regarding **claims 4, 12 and 26**, as applied to claims 1, 9 and 23, Granberg, as modified by Benco disclose the claimed invention. Benco further discloses wherein the first real-time, cost-per-unit-time billing rate comprises a cost-per-minute rate (see col. 3, lines 55-57).

Regarding **claims 6, 14 and 29**, as applied to claims 1, 9, and 28, Granberg, as modified by Benco disclose the claimed invention. Benco further discloses wherein the first rate description and the first real-time, cost-per-unit-time billing rate are simultaneously displayed by the display of the wireless telephone (see col. 4, lines 28-32).

Regarding **claim 7**, as applied to claim 1, Granberg, as modified by Benco disclose the claimed invention. Benco further discloses wherein transmitting the first real-time cost-per-unit-time billing rate and the first billing rate description comprises: transmitting data indicating the first real-time, cost-per-unit-time billing rate and the billing rate description (per-minute roaming charge, see figs. 1 and 2, col. 3, lines 20-25, lines 47-51) from the remote node (wireless network, see col. 4, lines 28-32) to the wireless telephone during the in-progress telephone call (see col. 4, lines 28-32).

Regarding **claim 10** as applied to claim 9, Granberg, as modified by Benco disclose the claimed invention. Benco further wherein the display is further to display, a second real-time, cost-per-unit-time billing rate and a second billing rate description associated with the second real-time, cost-per-unit-time billing rate during the in-progress telephone call (see col. 4, lines 17-40).

Regarding **claim 24** as applied to claim 23, Granberg further discloses the message generator is further to determine a second real-time, cost-per-unit-time billing rate (calculating a charge for a call due to changing conditions, see col. 6, lines 3-10) and transmitting the second real-time, cost-per-unit-time billing rate for display of the wireless telephone during the in-progress telephone call (displaying call charges during the call, see abstract, col. 6, lines 1-13). Benco further discloses determining a second billing rate description associated with the second real-time, cost-per-unit-time billing rate for the in-progress telephone call of the wireless telephone (see col. 4, lines 17-40), and generating a second message having data that indicates the second real-time, cost-per-unit-time billing rate and the second billing rate description (see col. 4, lines 17-

40); and the wireless service provider is further to transmit the second message to the wireless telephone for display of the second real-time, cost-per-unit-time billing rate and the second billing rate description during the in-progress telephone call (see col. 4, lines 17-40).

Regarding **claim 30** as applied to claim 28, Granberg as modified by Benco discloses the claimed limitation. Benco further discloses receiving at the wireless telephone a second real-time, cost-per-unit-time billing rate and a second billing rate description associated with the second real-time, cost-per-unit-time billing rate for the in-progress telephone call via the wireless telephone (receiving the per-unit roaming charge to the user as the user travels out of a service area and displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40); and displaying the second real-time, cost-per-unit-time billing rate and the second billing rate description on the display of the wireless telephone during the in-progress telephone call (displaying the roaming rate and roaming description such as "roaming rate: \$0.35/min" to the user, see col. 4, lines 17-40).

6. Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Granberg 6,195,543** in view of **Benco et al 7,068,997 (hereinafter Benco)** as applied to claim 23 above, and further in view of **Himelhoch 20050032505**.

Regarding **claim 27**, as applied to claim 23, Granberg, as modified by Benco discloses the claimed invention except wherein the message generator is further to generate a message indicating a number of days remaining in a billing period on the display.

In the same field of endeavor, Himelhoch discloses wherein a message generator (see fig. 1) is further to generate a message indicating a number of days remaining in a billing period on the display (see fig. 1, p.3, [0031], [0033]).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the teaching of Himelhoch, by having displaying a billing cycle on a screen of a cell phone, into the system of Granberg, as modified by Benco, for the benefit of providing subscribers with a way of keeping track of unused minutes, and minutes and costs that exceed the monthly plan.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUMIDE T. AJIBADE AKONAI whose telephone number is (571)272-6496. The examiner can normally be reached on M-F, 8.30p-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617